



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,309	03/05/2007	Kosuke Naito	G0126.0249	6752

32172 7590 03/05/2010
DICKSTEIN SHAPIRO LLP
1633 Broadway
NEW YORK, NY 10019

EXAMINER

PITT, BRYAN W

ART UNIT	PAPER NUMBER
----------	--------------

2617

MAIL DATE	DELIVERY MODE
-----------	---------------

03/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/599,309	NAITO ET AL.	
	Examiner	Art Unit	
	Bryan Pitt	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20 October 2009</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received 03 December 2009 and has been entered. Claims 1-9 were amended. Claims 1-9 are pending.

Information Disclosure Statement

2. The information disclosure statement filed 20 October 2009 has been considered.

Priority

3. The Examiner acknowledges the priority of the present application based on the submitted PCT documents. This has been noted in the Office Action Summary.

Response to Arguments

4. Applicant's arguments with respect to claim 1-9 have been considered but are moot in view of the new ground(s) of rejection.
5. The specification was amended to overcome the Examiner's objection.
6. The Applicant's response clarifies the claimed invention and thus overcomes the Examiner's rejection of claims 1, 5, 6 and 9 under 35 USC § 112, second paragraph, as being indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

Art Unit: 2617

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-2, 6-9 are rejected under 35 U.S.C. 102(e) as being anticipated by US 6,516,193 to Salmela et al.

Regarding claim 1, Salmela teaches a mobile communication system comprising a base station and a terminal,

the base station being operable to transmit a downlink signal that includes a base station ID number indicating the identity of the base station and a specific use identification signal that indicates the base station is for specific use (i.e. Salmela teaches a base station which broadcasts its identifier; Col. 1 line 60 to Col. 2 line 8. The base station also broadcasts a signal informing a user that a special service, such as reduced tariff, is available Col. 1 lines 16-28), and

the terminal comprising a memory that stores a list of base station ID numbers of an accessible base station or an inaccessible base station, the list including every specific use identification signal (i.e. Salmela teaches that the mobile station stores a list of authorized base stations, including base stations for which a special service is available; Col. 3 lines 43-52), and

the terminal being operable to search whether or not the base station ID number in the received downlink signal is in the list of base station ID numbers and whether the specific use identification signal detected from the downlink signal is ON and performing communication with the base station only when access is permissible (i.e. Salmela teaches that the mobile station compares the broadcast base station identifier to the

stored list of authorized base stations; Col. 10 lines 1-22. The mobile station is restricted to accessing only permitted cells; Col. 10 lines 23-32. The mobile station also detects whether the special service message is being broadcast; Col. 1 lines 16-29).

Regarding claim 2, Salmela teaches a mobile communication system according to claim 1, wherein the base station is operable to include the specific use identification signal to be included in a transmitted downlink common channel (i.e. Salmela teaches broadcasting the special service message, therefore transmitting on a downlink common channel; Col. 1 lines 16-29).

Regarding claim 6, Salmela teaches a base station in a mobile communication system, the mobile communication system comprising the base station and a terminal,

the base station being operable to transmit a downlink signal that includes a base station identification number indicating the identity of the base station and a specific use identification signal that indicates the base station is for specific use (i.e. Salmela teaches a base station which broadcasts its identifier; Col. 1 line 60 to Col. 2 line 8. The base station also broadcasts a signal informing a user that a special service, such as reduced tariff, is available Col. 1 lines 16-28),

the terminal comprising a memory that stores a list of base station identification numbers of an accessible base station or an inaccessible base station, the list including every specific use identification signal (i.e. Salmela teaches that the mobile station stores a list of authorized base stations, including base stations for which a special service is available; Col. 3 lines 43-52), and

the terminal being operable to search whether or not the base station identification number in the received downlink signal is in the list of base station identification numbers and whether the specific use identification signal detected from the downlink signal is ON and performing communication with the base station only when the access is permissible (i.e. Salmela teaches that the mobile station compares the broadcast base station identifier to the stored list of authorized base stations; Col. 10 lines 1-22. The mobile station is restricted to accessing only permitted cells; Col. 10 lines 23-32. The mobile station also detects whether the special service message is being broadcast; Col. 1 lines 16-29), and

the base station comprising an identification signal generation unit that generates the specific use identification signal and a modulation unit that allows the generated specific use identification signal and the base station identification signal to be included in the downlink signal and sends the downlink signal (i.e. Salmela teaches the base station broadcasting its identifier and the special service message on the broadcast control channel, therefore an identification signal generation unit and a modulation unit; Col. 1 lines 16-29 and line 60 to Col. 2 line 8).

Regarding claim 7, Salmela teaches a base station according to claim 6, wherein the base station allows the specific use identification signal to be included in a downlink common channel and sends the signal (i.e. Salmela teaches the base station broadcasting its identifier and the special service message on the broadcast control channel, therefore an identification signal generation unit and a modulation unit; Col. 1 lines 16-29 and line 60 to Col. 2 line 8).

Regarding claim 8, Salmela teaches a base station according to claim 6, further comprising an input unit that inputs whether or not a resource of the base station is to be occupied,

(i.e. Salmela teaches the base station can broadcast information indicating that its special service status is changing and the ongoing call will be cut off, therefore receiving an input whether or not a resource of the base station is to be occupied; Col. 4 lines 29-65),

wherein the identification signal generation unit generates the specific use identification signal on the basis of an input result of the input unit indicating that the resource of the base station is to be occupied (i.e. Salmela teaches that when the base station no longer offers the special service an ongoing call will be cut off, therefore it broadcasts the special service message when it is to be accessed (occupied); Col. 4 lines 29-65).

Regarding claim 9, Salmela teaches a terminal in a mobile communication system, the mobile communication system comprising a base station and the terminal,

the base station being operable to transmit a downlink signal that includes a base station identification number indicating the identity of the base station and a specific use identification signal that indicates that the base station is for specific use (i.e. Salmela teaches a base station which broadcasts its identifier; Col. 1 line 60 to Col. 2 line 8. The base station also broadcasts a signal informing a user that a special service, such as reduced tariff, is available Col. 1 lines 16-28),

the terminal comprising:

a memory that stores a list of base station identification number of an accessible base station or an inaccessible base station, the list including every specific use identification signal (i.e. Salmela teaches that the mobile station stores a list of authorized base stations, including base stations for which a special service is available; Col. 3 lines 43-52); and

a determination unit that searches whether or not the base station ID number in the received downlink signal is in the list of base station identification numbers and whether the specific use identification signal detected from the downlink signal is ON and performs communication with the base station only when the access is permissible (i.e. Salmela teaches that the mobile station compares the broadcast base station identifier to the stored list of authorized base stations; Col. 10 lines 1-22. The mobile station is restricted to accessing only permitted cells; Col. 10 lines 23-32. The mobile station also detects whether the special service message is being broadcast; Col. 1 lines 16-29).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Salmela in view of US 6,097,937 to Sawyer.

Regarding claim 3, Salmela teaches a mobile communication system according to claim 1, but does not specifically teach further comprising a mobile communication network connected to the base station, wherein the base station periodically sends the information to a database for storing the information indicating whether or not the specific use identification signal is sent, and the mobile communication network sending the information to a database for storing the information; however, at the time the invention was made the above limitation was well known in the art of communications.

Sawyer teaches a mobile communications system wherein a private microcell with a operating agreement with a public macrocell system periodically sends reports on its operating status to the MSC of the macrocell system; Col. 4 line 52 to Col. 5 line 8. The MSC places this information in a charging record (i.e. database) and adjusts the tariff applied to users of the microcell according to the microcell status; Col. 4 line 52 to Col. 5 line 8. This allows the macrocell operator to give the private microcell subscribers preferential status in the public macrocell when the microcell is inoperable and charge an extra surcharge when the private microcell is congested; Col. 5 line 57 to Col. 6 line 9. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to modify the mobile communications system of Salmela to adjust tariffs according to the status of base stations as taught by Sawyer in order to give preferential status to certain users while penalizing others for their excessive use of system resources.

Regarding claim 4, the combination of Salmela and Sawyer teaches a mobile communication system according to claim 3, wherein the mobile communication

network comprises a discount rate calculation unit that calculates a charge discount rate of a user of the base station on the basis of whether the user has used information on the base station stored in the database (i.e. Sawyer teaches that the mobile communications network discounts the tariff based on the information stored in the call record (database); Col. 4 lines 3-24).

Regarding claim 5, the combination of Salmela and Sawyer teaches a mobile communication system according to claim 4, wherein the discount rate calculation unit increases the charge discount rate of the user of the base station as the total time for sending the specific use identification signal is short or as the usage time or the amount of using packet of a general user other than the user of the base station is larger (i.e. Salmela teaches that the charge for the call is only discounted for those time periods when the mobile station is within special service cells, therefore as the total time for sending the specific use identification signal is short; Col. 12 lines 18-43).

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

Art Unit: 2617

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan Pitt whose telephone number is (571) 270-7466. The examiner can normally be reached on Monday - Friday 9:00 AM - 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/
Supervisory Patent Examiner, Art Unit 2617

/B. P./
Examiner, Art Unit 2617

Application/Control Number: 10/599,309
Art Unit: 2617

Page 11